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|--|-------------|----------------------|------------------------------|------------------|
| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO. |
| 09/903,081   | 07/10/2001  | Richard E. Demaray   | 9140.0014-00                 | 1225             |
| 22852 7590 04/13/2007<br>FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER<br>LLP<br>901 NEW YORK AVENUE, NW<br>WASHINGTON, DC 20001-4413 |             |                      | EXAMINER<br>HOFFMANN, JOHN M |                  |
|  |             |                      | ART UNIT<br>1731             | PAPER NUMBER     |
| SHORTENED STATUTORY PERIOD OF RESPONSE   |             |                      | MAIL DATE                    | DELIVERY MODE    |
| 3 MONTHS   |             |                      | 04/13/2007                   | PAPER            |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

|                              |                               |                                |  |
|------------------------------|-------------------------------|--------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>09/903,081 | Applicant(s)<br>DEMARAY ET AL. |  |
|                              | Examiner<br>John Hoffmann     | Art Unit<br>1731               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2007.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 14-20, 24-27 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-20, 24-27 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Information Disclosure Statement*

The information disclosure statement filed 10-19-2006 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the dates of publication for at least one non-patent document is not provided. From MPEP 609(III) : The date of publication

supplied must include at least the month and year of publication, except that the year of publication (without the month) will be accepted if the applicant points out in the information disclosure statement that the year of publication is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the particular month of publication is not in issue.

It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

The information disclosure statement filed 3/19/2007 fails to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 14-20, 24-27, and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Examiner could find no support for the newly claimed limitation that the core layer completely covers the entire area – either explicit or implicit. This is deemed to be a prima facie showing on failure to comply with the requirement. The burden is now on Applicant to show the requirement is complied with, or to amend the claims so that they comply.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-20, 24-27, and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Lines 9-10 of claim 14 refers to "the entire area" – there is no antecedent basis for this. Also, there is no indication as to what this entire area might be – by way of definition, description, or knowledge generally available to one of ordinary skill in the art.

### ***Claim Rejections - 35 USC § 103***

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nourshargh 4619680 in view of Liu 6117345 and Bazylenko 6154582.

See the prior Office actions for the manner in which the references were applied.

Claim 14 also newly requires that the core layer "completely covers the entire area of the ridge portion, the sidewall portion and the planar portion."

In order to examine this limitation, Examiner first interprets it, by giving the terms thereof the broadest reasonable interpretation in their ordinary usage in context as they would be understood by one of ordinary skill in the art in light of the written description in the specification, including the drawings, unless another meaning is intended by appellants as established in the written description of the specification, and without reading into the claims any limitation or particular embodiment disclosed in the specification. See, e.g., *In re Am. Acad. Of Sci. Tech. Ctr*, 267 F.3d 1359, 1364, 70 USPQ2d 1 827, 1830 (Fed. Cir. 2004); *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

There is no definition, disclosure or description of the claimed "entire area" or even any "area of the ridge portion, the sidewall portion, and the planar portion".

Moreover the "ridge portion", "sidewall portion" and "planar portion" are not described, defined or disclosed in any manner which would reasonably suggest a specific meaning

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was intended by applicant. This it is deemed that the claimed areas can be portions of any size, however small, and of any shape – and that there need not be any boundaries thereto – physical or otherwise. Thus “ridge portion” encompasses any portion (of any size, however small, and of any shape) of a ridge. Thus “sidewall portion” encompasses any portion (of any size, however small, and of any shape) of a sidewall. Thus “planar portion” encompasses any portion (of any size, however small, and of any shape) of the plane.

Nourshargh clearly has at least one portion of the ridge that is covered, a portion of the sidewall that is covered, and a portion of the planar area that is covered. These portions are deemed to be “the entire area” which is completely covered. As can be seen by applicant’s figure 4A, part of the sidewall is exposed, and thus is not completely covered. Thus it is clear that “sidewall portion” does not require the entire sidewall.

Moreover, the plain meaning of “portion” is substantially ‘an often limited part set off or abstracted from a whole’. Thus it is deemed that the broadest reasonable interpretation of the claimed portions encompasses a limited part (of the ridge/sidewall/plane) abstracted from the whole.

Claims 15-17, 24-26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nourshargh 4619680 in view of Liu 6117345 and Bazylenko 6154582 as applied to claim 14 above, and further in view of Klein 3850604.

See the prior Office actions for the manner in which the references were applied  
– as well as the above discussion.

Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nourshargh 4619680 in view of Liu 6117345, Bazylenko, Klein 3850604 and Kestigian 4915810.

See the prior Office actions for the manner in which the references were applied  
– as well as the above discussion.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nourshargh 4619680 in view of Liu 6117345 and Bazylenko 6154582 as applied to claim 14 above, and further in view of Makikawa 6615614.

See the prior Office actions for the manner in which the references were applied  
– as well as the above discussion.

### ***Response to Arguments***

Applicant's arguments filed 3/19/07 have been fully considered but they are not persuasive.

Applicant points out that the updated IDS form includes the year and month, 'where possible.' The rules make no provision for not including the required information, merely because it might not be possible to do so. Even if it were, applicant



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has not provided any evidence that reasonably suggests it truly is not possible to discover the dates of publication.

Applicant also argues that since Nourshargh (figure 2c) shows that the thickness of the core glass is less than the depth of the groove, that "the entire area" is not completely covered. This does not appear to be very relevant, because Applicant's figures 4a and 4b also show that Applicant's thickness is less than the depth of the groove. Thus applicant's invention is not "completely covered" as per the standard set forth by applicant in their arguments. Moreover, as set forth in the rejection above, the claim is met because there is a "sidewall portion" that is completely covered in Nourshargh. There is nothing that reasonably suggests that the claimed "portion" cannot be something less than the entire subwall – such contradicts the plain meaning of "portion".

It is further argued that Bazylenko cannot completely cover the entire area because Bazylenko etches/removes part of the core layer. This is not well taken: Applicant's own claims require a step of etching (removing) part of the core layer. Since the present claims require etching, one cannot reasonably conclude that a teaching of etching fails to read on the claim.

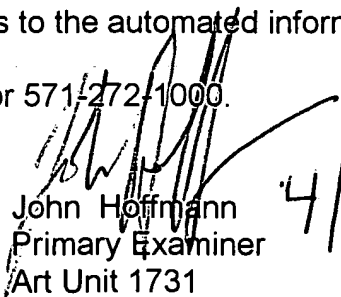
In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Thus it does not matter whether some of the references teach the "completely cover" limitation.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
John Hoffmann  
Primary Examiner  
Art Unit 1731

4/11/07

jmh